

REMARKS/ARGUMENTS

Solely in an effort to advance prosecution claim 1 is amended, and claims 3-4 and 17-19 are cancelled to encompass potentially infringing subject matter. **No new matter has been added.** Further, Applicant reserves the right to file continuing applications to cover disclosed subject matter not encompassed by the currently pending claims.

It is believed that the above claim amendments place this application in condition for allowance.

Claim Rejections Under 35 USC § 112

The Office Action rejects claims 1-20 under 35 USC § 112, second paragraph, as allegedly been undefined. In solely in an effort to advance prosecution, Applicant has amended claim 1, and cancelled claims 3-4 and 17-19 to address the clarity and antecedent basis concerns asserted by the Office Action. Applicant has removed the request for the second paragraph amendment indicated in the reply amendment of August 17, 2007.

In view of the claim amendments and removed of the second paragraph amendment, reconsideration and withdrawal of this rejection are respectfully requested.

Claim Rejections Under 35 USC § 103

The Office Action rejects claims 3 and 4 under 35 USC § 103 as allegedly being unpatentable over Pedahzur (Water Science and Technology, 31, 5-6, pp.123-129) and Komatsu at al (U.S.P.N. 6,121,191). Applicant has cancelled claims 3 and 4 in an effort to advance prosecution for allowance.

Claim Rejections Under 35 USC § 102

The Office Action rejects claims 1-20 under 35 USC § 102(b) as allegedly being unpatentable over Komatsu at al (U.S.P.N. 6,121,191). Applicant respectfully traverses this rejection.

Komatsu reference does not disclose a method, device and system for the body treatment and bacterial management, e.g. the use of plasmon excited nanoparticles for the body treatment and bacterial management that are disclosed by Applicant's instant claims. Komatsu merely discloses a method of increasing photocatalytic efficiency of titanium dioxide by attaching metal nanoparticles to titanium dioxide. It is, therefore, Applicants' position that the PTO failed to establish the requisite motivation in Komatsu that would have realistically impelled one having ordinary skill in the art to even attempt to modify the device and method of Komatsu in such a way as to arrive at the present invention, much less with the judicially required reasonable expectation of success. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Office Action has no identified wherein the four corners of the applied references the features of the presently claimed invention would have been obvious. It is incumbent upon the PTO to identify a source in the applied references for the asserted motivation. *Smiths Industries Medical System v. Vital Signs Inc.*, 183 F.3d 1347, 51 TSPQ2d 1415 (Fed. Cir. 1999), *In re Mayne*, 104 F.3d 1339, 4J USPQ2d 1451. (Fed. Cir. 1997). Rather, it would appear that the PTO's reliance upon the improper combination is an improper retrospective assessment of the claimed invention in light of Applicants' disclosure --a judicially condemned approach to the requisite realistic motivation element. *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989).


It is, therefore, Applicants' position that the PTO did not establish a *prima facie* basis to deny patentability to the claimed invention under 35 U.S.C. §102(b) for lack of the requisite realistic motivation. Moreover, upon giving due consideration to the improper combination of disparate applied references, the conclusion appears inescapable that one having ordinary skill in the art would not have found the claimed invention as a whole obvious within the meaning of 35 U.S.C. §102(b). Applicants, therefore, respectfully submit that the imposed rejections of claims

1, 2, 5-7, 9-10, 16 and 20 under 35 USC § §102(b) to deny patentability is not factually or legally viable and, hence, respectfully request reconsideration and withdrawal thereof.

Conclusion

All outstanding issues have been addressed. Taking into consideration the totality of the application as filed (i.e., the specification, claims and drawings), the currently amended application is in compliance with 35 USC § 112.

Sincerely,



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12/04/07

Date